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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/942,415	10/16/1997	YOSHIHARU KURODA	971154	8097
23850	7590	10/28/2003		
ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP 1725 K STREET, NW SUITE 1000 WASHINGTON, DC 20006				
			EXAMINER WALLERSON, MARK E	
			ART UNIT 2626	PAPER NUMBER

DATE MAILED: 10/28/2003

37

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
08/942,415

Applicant(s)
Kuroda et al

Examiner
Mark Wallerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 28, 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: |

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Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on **4/28/2003**.

2. This application has been reconsidered. Claims 1-13 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 2, 3, 6, 7, 8, 11, and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kojima et. al. (hereinafter referred to as Kojima) (U. S. 5,412,490) in view of Ono (U. S. 5,796,496) and Kitazawa (U. S. 5,078,380).

With respect to **claims 1, 6, and 11**, Kojima discloses a printing unit provided with an image reading unit comprising a main body (1); a recorded paper discharge tray (21, figure 3) located at the top of the unit; a document sheet supply tray (6) located below the recorded paper discharge tray (21); a document sheet outlet tray (7) located below the document sheet supply

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tray (6); a paper cassette (13) located below the document sheet outlet tray (7); a scanning unit (5) for transporting the document sheet from the document sheet supply tray (6) to the document sheet outlet tray (7); a recording part (image forming unit) (15) that transports the recording sheet from the paper cassette (13) to the recording sheet discharge tray (21), with the paper cassette (13), recorded paper discharge tray (21), document sheet supply (6) and document sheet discharge trays (7) being confined within a width of the device if viewed from the left of figure 3.

Kojima differs from **claims 1 and 6** in that although he discloses a paper cassette (13) below the document sheet outlet tray (7), he does not clearly disclose a multi-purpose tray below the document sheet outlet tray, and a recording sheet supply part located below the main body and independent of the multi-purpose tray for holding stacked recording sheets which are supplied one at a time, the recording sheet supply part including a paper cassette which is attachable and detachable from the image recording device.

Ono discloses an image processing system comprising a paper tray (which reads on a multi-purpose tray) (94, figure 1 and column 6, lines 1-2) for holding recording media (column 5, line 66 to column 6, line 2). It is also obvious from figure 1 that a user may be able to load paper sheets directly onto the tray (94). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kojima wherein a multi-purpose tray would be located below the document sheet outlet tray in place of the paper cassette (13). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified

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Kojima by the teaching of Ono in order to improve ease of operation by giving the user better access to the recording sheet tray.

Ono also discloses a recording sheet supply part (104) (comprising paper cassettes 98, 100, and 102, figure 1), provided below the main body (2) (which reads on the cassettes (98, 100, and 102 are removably arranged in a pedestal of the copying machine) (column 6, lines 4-6), which are attachable to and detachable from the image recording device (which reads on removably arranged in the copy machine) (column 6, lines 4-6), the paper cassette(s) capable of being manually loaded (which reads on removably arranged in the copy machine) (column 6, lines 4-6). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kojima wherein a recording paper supply part which is attachable to and detachable from the image recording device would have been installed below a multi-purpose tray. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kojima by the teaching of Ono in order to allow an operator to alternately select different recording sheets as disclosed by Ono in column 6, lines 38-40.

Kojima as modified also differs from **claims 1 and 6** in that he does not disclose a base having an upper surface and a multipurpose tray provided on the upper surface of the base.

Kitazawa discloses a copier (figure 1) comprising a base having an upper surface and a multipurpose tray (25) provided on the upper surface of the base (figure 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kojima as modified wherein the copier has a base having an upper surface and a multipurpose tray

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is provided on the upper surface of the base. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kojima as modified by the teaching of Kitazawa in order to allow a user to easily feed papers manually onto the tray.

With respect to **claims 2 and 7**, Kojima discloses the paper cassette (13) (multi-purpose tray) is connected horizontally so that a substantially space is between the paper cassette (13) (multi-purpose tray) and the document sheet outlet tray (7).

With respect to **claims 3 and 8**, Ono discloses that the recording supply sheet supply part comprises a cassette (column 6, lines 1-20) holding recording sheets in a stacked state (P, figure 1), and the paper cassettes are attachable to and detachable from the image recording device (which reads on removably arranged in the copy machine) (column 6, lines 4-6).

With regard to **claim 12**, Kojima discloses that the paper cassette (13) (multi-purpose tray) defines the bottom of the recording device (15).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. **Claims 4, 5, 9, 10, and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kojima in view of Ono and Kitazawa as applied to claims 1 and 6 above, and further in view of Sakaue (EUR 0 673 146 A2).

Kojima as modified differs from **claims 4, 5, 9, 10, and 13** in that he does not clearly disclose that the operation of the image recording device and paper cassette insertion/removal actions are performed by a user facing at right angles to a document transport direction and a recording sheet transport direction.

Sakaue discloses an image processor in which operation of the image recording device and paper cassette insertion/removal actions are performed by a user facing at right angles to a document transport direction and a recording sheet transport direction (figure 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the device of Kojima as modified wherein paper cassette insertion/removal actions would be performed by a user facing at right angles to a document transport direction and a recording sheet transport direction. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the device of Kojima as modified in order to achieve ease of use.

Response to Arguments

The Examiner notes that the reversal of the Examiners' obviousness rejection (35 U.S.C § 103) by the Patent Board of Appeals (Board) was based on the first step of the obviousness analysis - determination of the scope of the claims, and **NOT** on the scope and disclosure of the cited prior

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art as implied by Applicant in paragraph 2, page 8 of the Amendment filed on 4/28/2003. The claims were found to be indefinite by the Board, ergo the new ground of rejection by the Board under 35 U.S.C § 112, Second Paragraph.

Conclusion

7. All claims are rejected.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

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or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA.
Sixth Floor (Receptionist)


MARK WALLERSON
PRIMARY EXAMINER

Mark Wallerson